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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,794	04/25/2005	Masakazu Funahashi	28955.4026	6624

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EXAMINER	
GARRETT, DAWN L	

ART UNIT	PAPER NUMBER
1774	

MAIL DATE	DELIVERY MODE
05/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/532,794	FUNAHASHI, MASAKAZU	
	Examiner	Art Unit	
	Dawn Garrett	1774	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to the amendment filed March 5, 2007. No claims were amended. Claims 1-7 are pending.

2. The terminal disclaimer filed on March 5, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Application Serial No. 10/617,397 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. The rejection of claims 1-7 under 35 U.S.C. 102(e) as being anticipated by Matsuura et al. (US 2005/0064233 A1) is withdrawn due to the Declaration Under 37 CFR 1.132 signed February 27, 2007 (received March 5, 2007).

4. The rejection of claims 1-6 for obvious double-patenting over US Application No. 10/617,397 is withdrawn due to the terminal disclaimer.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

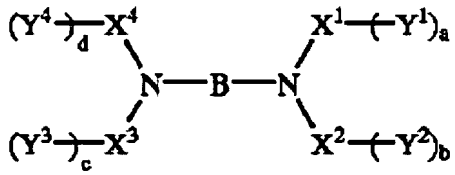
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hosokawa et al. (EP 1061112 or JP 2001-131541) and under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hosokawa et al. (US 6,951,693 or US 6,743,948). [Note: JP 2001-131541, US 6,951,693 and US 6,743,948 are patent family equivalents of EP 1061112].

Hosokawa et al. discloses electroluminescent elements comprising material according to formula [1]

general formula [1]



(1)

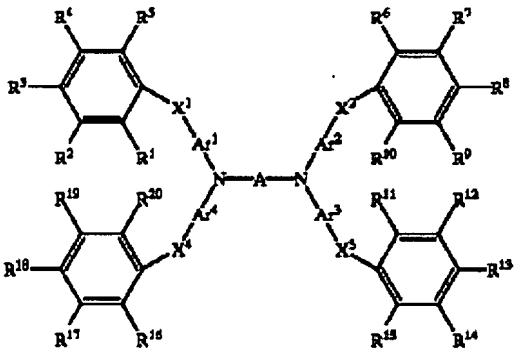
Y is according to formula [2] set forth by Hosokawa et al., but since a, b, c, and d may be zero, Y is not required (see abstract). See especially formula [4] of Hosokawa et al. showing the same aromatic ring group between the nitrogens, which is the same as required by instant claim 1. X groups may include substituted arylenes, which would include the at least one "A" groups as required by claim 1 (see EP claim 2). Hosokawa et al. clearly discloses the formulas may be used as light emitting material for organic electroluminescence devices with regard to claim 2 (see EP ref. Par. 33). It is preferred that the light emitting layer comprise 0.1-20% by weight of the formula 1 compounds with regard to claim 4 (see EP ref. paragraph 36). Hosokawa et al.

further discloses an EL device with an aromatic tertiary amine or phthalocyanine derivative between the light emitting layer and the anode with regard to claims 5 and 6 (see EP ref. Par. 39). With regard to claim 7, Hosokawa et al. discloses the formation of blue light emitting devices (see examples and Tables). Hosokawa et al. is deemed to anticipate the compounds of claim 1. In the alternative that Hosokawa et al. is not considered sufficient to anticipate each permutation of the claim 1 formulas, it would have been obvious to one of ordinary skill in the art at the time of the invention to have formed the compounds and to have used them in a light emitting device as claimed, because Hosokawa et al. teach all the required elements of claims 1-7.

8. Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Onikubo et al. (US 6,280,859).

Onikubo et al. discloses electroluminescent elements comprising material according to formula [1]

[1]



Onikubo et al. discloses A is a fused aromatic group (which would include the 4 member ring groups of claim 1) and Ar may be a substituted aromatic group (the substitution group reads upon instant "A" groups or alternatively, X of the above formula [1] may be an alicyclic residue) (see col. 2, lines 15-58).

Onikubo et al. clearly discloses the formulas may be used as light emitting material for organic electroluminescence devices with regard to claim 2 (see EP ref. Par. 33). It is preferred that the light emitting layer comprise 0.1-20% by weight of the formula 1 compounds with regard to claim 4 (see col. 4, lines 37-44)). Onikubo et al. further discloses an EL device with an aromatic tertiary amine or phthalocyanine derivative between the light emitting layer and the anode with regard to claims 5 and 6 (see col. 180, lines 24-58)). With regard to claim 7, Onikubo et al. discloses the formation of blue light emitting devices (see examples). Onikubo et al. is deemed to anticipate the compounds of claim 1. In the alternative that Onikubo et al. is not considered sufficient to anticipate each permutation of the claim 1 formulas, it would have been obvious to one of ordinary skill in the art at the time of the invention to have formed the compounds and to have used them in a light emitting device as claimed, because Onikubo et al. teach all the required elements of claims 1-7.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,743,948. General formulas 5 and 6 set forth B groups that are arylene groups having 6-60 carbon atoms, which encompass the group required by instant claim 1. The groups shown bonded to the nitrogens in formulas (5) and (6) read upon instant "A" groups in which the substituents are bonded to form rings. Furthermore, the "X" groups of general formula 5 may be substituted arylene groups with regard to the instant "A" groups.

11. Claims 3-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,743,948 in view of US 6,951,693. Claims 1 and 2 disclose the compound of the present application. US '693 discloses it would have been obvious to one of ordinary skill in the art at the time of the invention to have used light emitting material such as the material taught by '948 in a light emitting device as required by claims 3-7 (see '693 claims and entire document).

12. Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 11/282,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because the formula 1 compound of '697 claim 1 encompasses formula (I) of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

5. Applicant's arguments with respect to the claims has been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (571) 272-1523. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dawn Garrett
Primary Examiner
Art Unit 1774